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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,510	12/14/2001	Syunji Sugaya	P/2850-53	4552
2352	7590	03/14/2006	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			BOVEJA, NAMRATA	
		ART UNIT	PAPER NUMBER	
		3622		

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/018,510	SUGAYA, SYUNJI
	Examiner Namrata Boveja	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 December 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-54 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 December 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5/9/05, 2/26/04, 1/12/04, 5/2/02, 12/14/01</u>	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

1. Claims 1-54 are presented for examination.

### Claim Rejections - 35 USC § 112

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention. There are two separate requirements set forth in this paragraph:  
(A) the claims must set forth the subject matter that applicants regard as their invention; and  
(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

2. Claims 3, 19, and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 39 teach a method, system, and program wherein the user side equipment reproduces the said advertisements by “animation”. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “animation” in claims 3 and 39 is used by the claim to mean download data over the Internet, reproduce the advertisement using software, and control advertisement scheduling also using the software as interpreted from the applicant specification on page 3 where steps 15, 2, 40, 56, 66, and 86 characterize reproduction of the

advertisements by “**animation**”, while the accepted meaning of the term “**animate**” is “to make or design in such a way as to create apparently spontaneous lifelike movement or to produce in the form of an animated cartoon” by the Merriam-Webster Online Dictionary (<http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=animate>). The term is indefinite because the specification does not clearly redefine the term. Therefore, the interpreted description of word from the specification steps above is utilized in examining the application.

Clarification is required.

3. Claim 19 teaches a program for presenting advertisements with various steps. First of all if the applicant is trying to claim a system, the computer program should be embedded in a computer readable medium. Secondly, the recitation of steps leads to the interpretation of this being a method claim. It is therefore unclear if this is a system or a method claim. Clarification is required.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1- 3, 5-6, 8-10,17-21, 23-24, 26-28, 35-39, 41-42, 44-46, and 53-54 are rejected under 102(e) as being anticipated by Servan-Schreiber et al (Patent Number 6,892,354 hereinafter Servan-Schreiber).

**Disclaimer:** Claim 19 was found to be deficient under U.S.C. 112 second. To the extent the claimed invention was understood, the following art was applied.

In reference to claims 1, 19, and 37, Servan-Schreiber teaches a method, system, and program of presenting advertisements comprising; a step for transferring data to or from a server via a network (col. 1 lines 58-63, col. 2 lines 1-5 and 49-65, col. 3 lines 10-16, and Figure 1), and a step for presenting advertisements on said user side equipment to a user while transferring data (col. 1 lines 47-63, col. 2 lines 1-10 and 49-65, col. 3 lines 22-43, and Figure 5A).

5. In reference to claims 2, 20, and 38, Servan-Schreiber teaches a method, system, and program including a step for delivering said advertisements to said user side equipment (col. 1 lines 47-63, col. 2 lines 1-10 and 49-65, col. 3 lines 22-43, and Figures 4, 5A, and 5B).

6. **Disclaimer:** The claims 3 and 39 were found to be deficient under U.S.C. 112 second. To the extent the claimed invention was understood, the following art was applied.

In reference to claims 3, 21, and 39, Servan-Schreiber teaches a method, system, and program including a step where said user side equipment reproduces said advertisements by animation (i.e. downloading data over the Internet, reproducing the advertisement using software, and controlling advertisement scheduling also using the

software) (col.1 lines 47-63, col. 2 lines 49-65, col. 3 lines 6-21 and 44-67, and col. 4 lines 1-6).

7. In reference to claims 5, 23, and 41, Servan-Schreiber teaches a method, system, and program including a step for selecting one or a plurality of advertisements to present to the user from among a plurality of advertisements based on said personal history information (col.4 lines 50-60).

8. In reference to claims 6, 24, and 42, Servan-Schreiber teaches a method, system, and program characterized in that said personal history information contains the content or type of data transferred by the user (i.e. what keywords are searched and which sites are accessed), advertisements presented to the user, or the user's personal characteristics information (i.e. statistical profile data) (col.4 lines 50-60).

9. In reference to claims 8, 26, and 44, Servan-Schreiber teaches a method, system, and program including a step for executing or opening data transmitted to said user side equipment after an advertisement has finished being presented to said user (i.e. advertisement pages are slipped in between request for webpages) (col. 4 lines 1-23), or when a predetermined operation is performed by said user during advertisement presentation (i.e. user accesses a hyperlink) (col. 2 lines 49-65 and col. 4 lines 14-41 and 61 to col. 5 lines 7).

10. In reference to claims 9, 27, and 45, Servan-Schreiber teaches a method, system, and program including a step where said user side equipment presents the advertisements to the user while downloading data from said server via said network

(col. 1 lines 47-63, col. 2 lines 1-10 and 49-65, col. 3 lines 22-43, and Figures 4, 5A, and 5B).

11. In reference to claims 10, 28, and 46, Servan-Schreiber teaches a method, system, and program including a step where said user side equipment downloads data (i.e. the contents of an advertisement) and software (i.e. a web browser to display the webpage advertisement) required to use this data from said server via said network (col. 2 lines 1-5, col. 3 lines 6-16 and 35-43, col. 4 lines 1-6 and 24-31, and Figures 2 and 7).

12. In reference to claims 17, 35, and 53, Servan-Schreiber teaches a method, system, and program including a step for adjusting transfer speed based on the state of presentation of said advertisement while data is transferred between said server and said user side equipment via said network (col. 3 lines 30-67 and col. 4 lines 1-13).

13. In reference to claims 18, 36, and 54, Servan-Schreiber teaches a method, system; and program according to claim including a step for finishing data transfer at the same time as or after presentation of said advertisement is completed (col. 3 lines 30-67 and col. 4 lines 1-13).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 4, 7, 11-16, 22, 25, 29-34, 40, 43, and 47-52 are rejected under U.S.C. 103(a) as being unpatentable over Servan-Schreiber in view of Official Notice.

In reference to claims 4, 22, and 40, Servan-Schreiber teaches a method, system, and program for collecting and using personal history information regarding a user of said user side equipment (i.e. statistical information, profile information, items searched, and other information is determined and used in selecting advertisements for display) (col.4 lines 50-60). Servan-Schreiber is silent about storing personal history information.

Official Notice is taken that it is old and well known to store personal history information in the field of advertising to target advertisements based on personal history information. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include storing of the personal history information to enable advertisers to access this information on more than one occasion for targeting appropriate product and services advertisements that will be most valuable to the consumers.

15. In reference to claims 7, 25, and 43, Servan-Schreiber does not teach a method, system, and program for including a step for selecting one or a plurality of advertisements to present to a user from among a plurality of advertisements based on the environment (i.e. drivers and software installed) of said user side equipment.

Official Notice is taken that is old and well known to present content in different formats based on the user's environment. For example, if the user's computer does not have the software that supports the viewing of a Flash or video presentation, a user

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may be provided the option to view the information in text or audio format or download the Flash software. As an another example, if the user is using a different version of the Microsoft Word software on his computer, he might be asked to convert a Word file he received in an e-mail in order to be able to view it with the version of Word that is installed on his machine, and this conversion may cause the document to look slightly different on his machine if for example he does not have the same fonts installed on his computer. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include presenting content in different formats based on the user's environment to enable advertisers to reach a broad base of target users regardless of the type of computer system the users may be using.

16. In reference to claims 11, 29, and 47, Servan-Schreiber teaches the system characterized in that said user side equipment presents the advertisements to the user while downloading data to said server via said network and during idle and wait time (col. 1 lines 47-63, col. 2 lines 1-10 and 49-65, col. 3 lines 22-43, and Figure 5A). Servan-Schreiber does not specifically recite presenting advertisements while uploading data to said server via said network, even though uploading also leads to an idle and wait time.

Official Notice is taken that is old and well known to present advertising content while uploading data to a server via a network to make an effective use of wait time as done by e-mail providers such as Juno when users are waiting to upload file attachments to their e-mail messages to help keep the e-mail service free of charge to the users and to give users something to look at while waiting on their computers for the

upload to be completed. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include presenting advertisements during uploading of data to provide the users with targeted advertising for viewing while waiting for the upload to be completed.

17. In reference to claims 12, 30, and 48, Servan-Schreiber teaches a method, system, and program including a step for requesting said user to input information interactively (i.e. user clicks on or manually enters a hyperlink request) when data is transferred between said server and said user side equipment via said network (abstract, col. 2 lines 49-65, and Figure 2. Servan-Schreiber is silent about including a step for storing responses input by said input request section.

Official Notice is taken that it is old and well known to store response input information in the field of e-commerce. For example, when a user has an online account with a vendor, the vendor can offer to store the user's credit card information associated with the online account so that the user does not have to re-type in that information each type when the user is making an online transaction. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include storing of response input information (i.e. manually typing in something) to help users save time by automatically filling in this information on any required forms online.

18. In reference to claims 13, 14, 31, 32, 49, and 50, Servan-Schreiber does not teach a method, system, and program including a step for accessing and retrieving responses stored in said response storage section.

Official Notice is taken that it is old and well known to access and retrieve responses stored in a response storage section in the field of advertising. For example, personal data collected from surveys is stored in a database and is accessed and retrieved for sending e-marketing communication messages such as e-mail blasts targeted to different customer segments such as contractors, distributors, and original equipment manufacturers. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include access and retrieval of response input information to target advertisements more effectively for users of the services and products.

19. In reference to claims 15, 33, and 51, Servan-Schreiber does not teach the method, system, and program including a step for executing sales of products or services to said user while data is transferred to or from said server via said network.

Official Notice is taken that it is old and well known to execute sales of products or services to said user while data is transferred to or from said server via said network. For example, if a user opens up two Internet browser windows, he could be making an online purchase using a credit card and transferring this credit card information to the merchant in one window, and he could be viewing a product advertisement in another window simultaneously while waiting for the credit card transaction to go through. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to execute sales of products or services to said user while data is transferred to or from said server via said network to utilize the user's time more

effectively by enabling data transfer and sales execution to take place simultaneously in two different browser windows.

20. In reference to claims 16, 34, and 52, Servan-Schreiber does not teach a method, system, and program including a step for virus checking, defragmenting, or deleting unnecessary files from said user side equipment while data is transferred to or from said server via said network.

Official Notice is taken that it is old and well known to perform a virus check on the user side equipment while data is transferred to or from said server via said network. For example, many companies manage and secure electronic communications by using a software program to check the content of incoming and outgoing e-mails to prevent any viruses from entering user computer systems when a user attaches files to an e-mail message. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to perform a virus check on the user side equipment while data is transferred to or from said server via said network to prevent any viruses from entering or exiting the user side equipment.

**Conclusion**

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

- a) Shaw Patent Number 5,809,242. Teaches a method for displaying advertisements while composing and sending e-mails to subsidize the cost of electronic mail service.

b) "NEXOR: NEXOR Interceptor – The next generation of secure messaging and intelligent routing technology." M2 Presswire. July 6, 1999. Page 1.

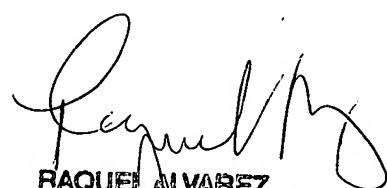
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

March 3<sup>rd</sup>, 2006



RAQUEL ALVAREZ  
PRIMARY EXAMINER